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| 10/673,754 | 09/29/2003 | Ifedayo Udiani | 39576 | 1464 |
| 7590 IFEDAYO UDIANI 40 BAYOU AVENUE CAPITOL HEIGHTS, MD 20743 | | | | |
| EXAMINER | | | | |
| GREGG, MARY M | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/673,754

Applicant(s)

UDIANI, IFEDAYO

Examiner

MARY M. GREGG

Art Unit

4124

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Priority

1. This application is claiming the benefit of prior-filed provisional application No. 60414451 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and a **non-provisional** prior application is required. Since the prior application is not a **non-provisional** application, the benefit claim to the prior-filed provisional application is improper. The applicants claiming of benefits of a provisional application should not be called a "continuation" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional applicant, not a continuation, division or continuation-in-part of the provisional application. If applicant desires to claim the benefits of a provisional application, the applicant must do so under 35 U.S.C 119(e). (See MPEP 201.07 [R-3], 35 U.S.C. 119(3) and MPEP 201.11 (III)(B)).

Oath/Declaration

2. The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602. 3.

The applicant has submitted a PTO/SB/01A (10-01) form indicating the submission of an application data sheet and has noted on the transmittal form (PTO/SB/05 (03-01)) an application data sheet, however, there was not an application data sheet submitted. It is required that either these forms be corrected or an application data sheet be submitted.

A new oath or declaration is required because of incorrect reference to provisional application. The applicant must note that the specification "is attached hereto" (PTO/SB/01 (10-01)) on the declaration. Additionally, the applicant if the applicant submits an application data sheet the applicant must note the declaration is directed to "the attached application" (PTO/SB/01A (10-01)). The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Specification

3. The abstract of the disclosure is objected to because an abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The submitted abstract is 213 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. The claims 1-4 are objected to because they include characters within parentheses which are not reference characters. The use of parenthesis makes unclear as to whether what is encompasses is a claimable limitation.

Characters within parentheses in a claim are for the purpose of referencing characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in

the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

5. Claims 2-3 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 2 and 3 reference "step 3" and "step 2" respectively in the preamble and makes it unclear if the claims include every limitation of the claim from which they depend.

Claim Rejections - 35 USC § 112/101

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-4 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. (See MPEP 1504.04 [R-5] (I) and MPEP 1503.02)).

In reference to Claim 4:

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention. A single claim which is directed toward an apparatus and process steps is indefinite. (See MPEP 2173.05(p) (II)).

Additionally, claim 4 is directed toward a method for a third party server to accept all currency, however there are no steps describing said method which renders the claim indefinite (see MPEP 2106 and 2174).

In reference to Claim 2:

Claim 2 provides for the use of e-stamps, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 2 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

In reference to Claim 3:

Claim 3 provides for the use of email, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

Art Unit: 4124

intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 3 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. The claimed invention of claim 4 is directed to non-statutory subject matter.

In reference to Claim 4:

A single claim which claims both an apparatus and method steps is directed to neither a "process" nor a "machine", but consists of two different statutory classes and therefore contains non-statutory subject matter.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 - 4 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pub No. 2005/0177437 A1 by Ferrier (Ferrier).

In reference to Claim 1:

A global method of effecting payments over the Internet between users and merchants/service providers (para 0077, lines 4-5), said method achieved by creating a third party institution (via gateway) which electronically provides the infrastructure to make and receive payments online from anywhere (FIG. 3, 4 and 6) and, consists of the following steps:

The third party issues Internet Units of Value (using a combination of smart cards encrypted with country specific codes (para 51, lines 7-11, para 0085, lines 8-16) and other data encryption technologies) which may be freely purchased by Internet users world wide (para 0054, lines 1-3, para 0058, lines 6-9, para 0064, lines 4-8); user logs on to the web through an existing or new email address and when prompted loads the encrypted information on the IUV to create an 'electronic account' (para 0057, lines 7-15, 20-23) and can subsequently add value(s) to it (para 0058, lines 6-9); when user makes an online purchase decision the purchase value is checked with the balance of the electronic account and if the account balance exceeds or, equals the purchase value the account is debited while the merchant's account is credited (para 0064, lines 1-8, 21-29, para 0067, lines 4-7, 22-27); on the receipt of the order the merchant issues an electronic receipt in the form of a confirmatory email to the user and then renders service or, ships product(s) to close the transaction (para 0087, lines 1-3).

Art Unit: 4124

Note: The prior art is directed toward a pre-pay escrow account, a pre-pay account inherently requires sufficient funds to pay for a purchase, hence the term "pre-pay".

In reference to Claim 2:

A method as claimed in step 3 of claim 1 (see rejection of claim 1 above) will stem the tide of unsolicited/junk mails on the world-wide web by discouraging mass mailing of worthless or harmful mails, and other acts of cyber terrorism with the aim of making the Internet more user friendly, business-like and secure, said method achieved by making the purchase and electronic affixing of electronic-stamps (e-stamps) mandatory on email messages either before they are sent by mailer(s) or responded to by users.

Note: The mere recitation of merits and advantages of a use of a product without method steps directed toward an invention is non-functional descriptive matter.

In reference to Claim 3:

A method as set forth in step 2 claim 1 (see rejection of claim 1 above) will make the ownership and operation of a valid email address the only gateway for user access to any site on the World Wide Web whether or not such website(s) offer services for free or, for a fee with the aim of eliminating anonymous browsing and, enabling visitors to websites to leave traces in the form of 'electronic foot/ finger prints' (EFP) which may be useful to law enforcement authorities in tracking security breeches world-wide

Note: Any "valid email address" inherently leaves traces such as an "electronic foot/finger print" and therefore would leave a path for authorities to follow if desired.

Additionally, the mere recitation of merits and advantages of a use of a product without method steps directed toward an invention is non-functional descriptive matter.

In reference to Claim 4:

A method according to claim 1 (see rejection of claim above 1) wherein the third party's server is configured to accept all national currency values and converts them to dollar values using a rates converter at prevailing exchange rates in the task of administering the electronic accounts (para 0085, lines 8-16); a system wherein Internet merchants' websites are linked to the third party's server to record transactions (para 0072, lines 1-3, FIG 1, 3, 4 and 5) as they occur real time and; a system wherein the third party provides for the collection of all applicable country specific online point-of-sale taxes (for taxable goods/services) deducts same, and forwards the proceeds to relevant tax authorities(para 0082, lines 4-7, para 0083, FIG 5)

Conclusion

11. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent

Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 5,999,967 by Sundsted is directed toward e-stamp use and technology. Whereas, US Pub No. 2004/0138353 A1 by Fleishman is directed toward an online payment transfer and identity management system. This art is directed toward payments within online banking accounts and other bank delivery channels with confirmation of transactions followed by email.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY M. GREGG whose telephone number is (571)270-5050. The examiner can normally be reached on Monday thru Friday- 8:30am-5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Bombeck can be reached on (571) 272-4922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4124

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MMG
/Kenneth Bomberg/
Supervisory Patent Examiner, Art Unit 4124